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Steven O. Markel

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EXAMINER

VU, NGOC K

ART UNIT

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2623

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 09/997,022	<b>Applicant(s)</b> MARKEL, STEVEN O.	
	<b>Examiner</b> NGOC K. VU	<b>Art Unit</b> 2623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 April 2008.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,4-7,9-14,16,17,19,22-25 and 27-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,4-7,9-14,16,17,19,22-25 and 27-29 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/23/2008 has been entered.

***Response to Arguments***

2. Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1, 4-7, 9-14, 16, 17, 19, 22-25, and 27-29 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With respect to independent claims, the claimed features of disabling at least one **previously-enabled size** control function of the display window, disabling at least one **previously-enabled size** control function of the video presentation window in response to the ad event signal, disabling at least one **previously-enabled size** control function of the video presentation window, disabling at least one **previously-enabled size** control function of a display window in response to the ad event signal, wherein at least **previously-enabled size** control function of the display window is

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disabled” were not described in the specification. (Emphasis added). In fact, the specification discloses that some or all controls for the window are disabled (page 7, lines 18-19, 26-27; page 8, lines 17-18; page 9, lines 1-2). However, this disclosure does not explicitly indicate that control for window comprises disabling at least one previously-enabled size control function as claimed.

Further regarding claim 7, it partly calls for pausing presentation of the streaming video program, disabling at least one previously-enable size control function of the video presentation window, adjusting the video presentation video to a predetermined size and re-enabling the at least one size control function of the video presentation window. In light of the specification, the most relevant disclosures are found at figures 6 and 8, pages 7, lines 22+ and page 8, lines 29+. This indicates that the specification does not disclose such features from the combination of embodiments of figure 6 and figure 8 as claimed. Furthermore, the specification does not explicitly describe restoring size window controls or “re-enabling at least one **size** control function of the video presentation/display window” as recited in claims 7, 16, and 19. Further regarding claim 23, according to the specification, the most relevant disclosures are found at figure 9 and page 9, lines 14+. However, the specification does not describe the claimed feature of adjusting the size of display window to a predetermined size in response to the ad event signal. With respect to claim 24, the specification does not describe the feature of preventing resizing of the display window **for a predetermined amount of time** as claimed. (Emphasis added).

### ***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 7, 9-11, and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US 6,698,020) in view of Kanter (US 20020032608 A1).

Regarding claim 7, Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising: presenting a streaming video program in a video presentation window (displaying a video program on a screen 58) (see Fig. 7 and 58; Fig. 8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37), pausing presentation of the streaming video program in response to the ad event signal (the advertisement insertion device interrupts the display of the video programming in response to the trigger signal - column 15, lines 57-61; col. 17, lines 25-31); adjusting said video presentation window to a predetermined size in response to said ad event signal (the advertisement is displayed on a display screen in a full screen size in response to the trigger signal. See column 15, lines 57-61; col. 17, lines 25-31); displaying advertising in said video presentation window in response to said ad event signal (column 15, lines 57-61; col. 17, lines 25-31); re-enabling said at least one size control function of said presentation window (returning of displaying the video program on the screen in a full screen size after the advertisement is complete - col. 16, lines 40-41; col. 17, lines 35-37) and resuming presentation of the streaming video program (col. 17, lines 35-37).

Zigmond fails to teach disabling at least one previously-enabled size control function of the display window in response to the ad event signal. However, Kanter discloses that user has no control over the ad window such as minimizing the ad in response to a control signal. See 0017. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Zigmond by disabling at least one previously-enabled size control function, e.g., minimizing the display window, in response to a control

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signal as disclosed in Kanter in order to allow advertiser to maximize the effectiveness of their ad campaigns.

Regarding claim 9, Zigmond inherently teaches adjusting the display window to full-screen size (See column 15, lines 57-61; col. 17, lines 25-31).

Regarding claim 10, Zigmond discloses the ad even signal that is embedded in the streaming video program (column 8, lines 39-41; col. 15, lines 47-52).

Regarding claim 11, Zigmond discloses the ad event signal that is generated by a software program operating at the receiver (the system includes computer-readable media having computer executable instructions and software is included in the ad insertion device - see column 6 lines 48-50 line 26-36; col. 15, lines 40-44).

Regarding claim 23, Zigmond discloses a method for displaying advertising comprising: presenting a first streaming video program in a video presentation window (58) (see figures 7-8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37); adjusting the size of said display window to a predetermined size in response to said ad event signal (the ad insertion device 80 interrupts display of the video programming content to insert in its place a selected advertisement based upon the presence of a triggering signal. It must be understood that the ad insertion device 80 arranges or makes suitable for displaying the advertisement on a display screen in full screen size response to the trigger signal. See column 15, lines 57-61; col. 17, lines 25-31); displaying a first advertisement associated with the first streaming video program in response to the ad event signal (see column 7, lines 26-32); receiving a second streaming video program (the program feed will include a first and any other subsequent streaming video programs - see column 7, lines 23-25); setting an indicator if an advertisement is being presented in conjunction with the second streaming video program (the advertisement inserting

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device inserts advertisements in the programming feed in response to a trigger signal - see col. 8, lines 51-54; col. 15, lines 35-37 and 52-65); displaying a second advertisement associated with the second streaming video program if the indicator is set (col. 8, lines 30-38; col. 15, lines 52-65; col. 13, lines 48-58); presenting the second streaming video program in the video presentation window (the system displays a first and any subsequent streaming video program column 7, lines 23-25).

Zigmond does not explicitly teach disabling at least one previously-enabled size control function of a display window in response to the ad event signal. However, Kanter discloses that user has no control over the ad window such as minimizing the ad in response to a control signal. See 0017. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Zigmond by disabling at least one previously-enabled size control function, e.g., minimizing the display window, in response to a control signal as disclosed in Kanter in order to allow advertiser to maximize the effectiveness of their ad campaigns.

7. Claims 1, 4-6, 17, 19, 22, 24, 25, and 27-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Zigmond (US 6,698,020) in view of Rashkovskiy (US 6,912,504 B1) and further in view of Kanter (US 20020032608 A1).

Regards to claim 1, Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising: presenting a streaming video program in a video presentation window (displaying a video program on a screen 58) (see Fig. 7 and 58; Fig. 8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37), pausing presentation of the streaming video program in response to the ad event signal (the advertisement insertion device interrupts the display of the video programming in response to the trigger signal - column

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15, lines 57-61; col. 17, lines 25-31); and resuming presentation of the streaming video program (after the advertisement is complete, resuming display of the video program on the display screen - see col. 16, lines 40-41; col. 17, lines 35-37).

Zigmond does not teach opening a display window in response to the ad event signal and adjusting the display window to a predetermined size, displaying advertisement in the display window, and closing the window in response to the one or more advertisements completing. However, Rashkovskiy teaches that advertisement is displayed full screen in an Internet browser in response in a control signal and once the advertisement has been completely played, access to the content/services may be resumed. See col. 2, lines 58-60 and col. 3, lines 10-16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Zigmond by opening a display window, e.g., Internet browser, in response to a control signal, and adjusting the display window to a predetermined size, e.g., full screen, for displaying advertisement and closing the window in response to the one or more advertisements completing as taught by Rashkovskiy in order to provide advertising via the Internet to support various services and content that may be received over the Internet and further increase effectiveness of presenting advertisement to viewer.

Both Zigmond and Rashkovskiy fail to teach disabling at least one previously-enabled size control function of the display window. However, Kanter discloses that user has no control over the ad window such as minimizing the ad. See 0017. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Zigmond and Rashkovskiy by disabling at least one previously-enabled size control function, e.g., minimizing the display window, as disclosed in Kanter in order to allow advertiser to maximize the effectiveness of their ad campaigns.



Regarding claim 4, Zigmond as modified by Rashkovskiy teaches adjusting the display window to full-screen size (see Rashkovskiy: col. 3, lines 13-16).

Regarding claim 5, Zigmond discloses the ad even signal that is embedded in the streaming video program (column 8, lines 39-41; col. 15, lines 47-52).

Regarding claim 6, Zigmond discloses the ad event signal that is generated by a software program operating at the receiver (the system includes computer-readable media having computer executable instructions and software is included in the ad insertion device - see column 6 lines 48-50 line 26-36; col. 15, lines 40-44).

Regarding claim 17, Zigmond discloses a method for displaying advertising comprising: presenting a streaming video program in a video presentation window (58) (see figures 7-8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37); pausing presentation of the streaming video program in response to the ad event signal (the advertisement insertion device interrupts the display of the video programming in response to the trigger signal - column 15, lines 57-61; col. 17, lines 25-31); saving the contents of the display window (the paused video program is saved since it is opened back up to its pre-advertisement position once the advertisement has been displayed in its entirety – see column 7, lines 26-32 and column 16, lines 35-45); restoring the contents of the display window (the paused video program is restored since once the advertisement has been displayed, the video presentation window opens back up at the position in which it was last at before the advertisement was displayed, column 7, lines 26-32 and column 16, lines 35-45); and resuming presentation of the streaming video program (column 16, lines 35-41; col. 17, lines 35-37).

Zigmond does not teach selecting a display window in response to the ad event signal and adjusting the display window to a predetermined size and displaying advertising in the

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display window. However, Rashkovskiy teaches that advertisement is displayed full screen in an Internet browser in response to a control signal and once the advertisement has been completely played, access to the content/services may be resumed. See col. 2, lines 58-60 and col. 3, lines 10-16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Zigmond by selecting a display window, e.g., Internet browser, in response to a control signal for displaying advertisement and adjusting the display window to a predetermined size, e.g., full screen, as taught by Rashkovskiy in order to provide advertising via the Internet to support various services and content that may be received over the Internet and further increase effectiveness of presenting advertisement to viewer.

Both Zigmond and Rashkovskiy fail to teach disabling at least one previously-enabled size control function of the display window. However, Kanter discloses that user has no control over the ad window such as minimizing the ad. See 0017. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Zigmond and Rashkovskiy by disabling at least one previously-enabled size control function, e.g., minimizing the display window, as disclosed in Kanter in order to allow advertiser to maximize the effectiveness of their ad campaigns.

Regarding claim 19, Zigmond teaches re-enabling said at least one size control function of said display window (returning of displaying the video program on the screen in a full screen size after the advertisement is completed - see col. 16, lines 40-41; col. 17, lines 35-37).

Regarding claim 22, Zigmond as modified by Rashkovskiy teaches adjusting said video presentation window to a predetermined size (see col. 3, lines 13-16).

Regarding claim 24, Zigmond as modified by Kanter teaches preventing resizing of said display window for the display window for a predetermined amount of time (the advertisement is

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displayed for a specified period of time, e.g., 20-30 seconds, and the window for presenting advertisement can not be minimized while the advertisement is presenting. See 0017 and 0034).

Regarding claim 25, Zigmond discloses a method for displaying advertising in conjunction with a streaming video program comprising: presenting a streaming video program in a video presentation window (displaying a video program on a screen 58) (see Fig. 7 and 58; Fig. 8 and column 7, lines 23-25); receiving an ad event signal (trigger signal) that indicates that an ad is to be displayed (see col. 8, lines 51-54; col. 15, lines 35-37), pausing presentation of the streaming video program in response to the ad event signal (the advertisement insertion device interrupts the display of the video programming in response to the trigger signal - column 15, lines 57-61; col. 17, lines 25-31); and resuming presentation of the streaming video program (see col. 16, lines 40-41; col. 17, lines 35-37).

Zigmond does not teach opening a display window in response to the ad insert event signal and adjusting the display window to a predetermined size, displaying advertisement in the display window, and closing the window in response to the one or more advertisements completing. However, Rashkovskiy teaches that advertisement is displayed full screen in an Internet browser in response to a control signal and once the advertisement has been completely played, access to the content/services may be resumed. See col. 2, 58-60 and col. 3, lines 10-16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Zigmond by opening a display window, e.g., Internet browser, and adjusting the display window to a predetermined size, e.g., full screen, for displaying advertisement and closing the window in response to the one or more advertisements completing as taught by Rashkovskiy in order to provide advertising via the

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Internet to support various services and content that may be received over the Internet and further increase effectiveness of presenting advertisement to viewer.

Both Zigmond and Rashkovskiy fail to teach disabling at least one previously-enabled size control function of the display window. However, Kanter discloses that user has no control over the ad window such as minimizing the ad. See 0017. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Zigmond and Rashkovskiy by disabling at least one previously-enabled size control function, e.g., minimizing the display window, as disclosed in Kanter in order to allow advertiser to maximize the effectiveness of their ad campaigns.

Regarding claim 27, Zigmond as modified by Rashkovskiy teaches adjusting the display window to full-screen size (see Rashkovskiy: col. 3, lines 13-16).

Regarding claim 28, Zigmond discloses the ad even signal that is embedded in the streaming video program (column 8, lines 39-41; col. 15, lines 47-52).

Regarding claim 29, Zigmond discloses the ad event signal that is generated by a software program operating at the receiver (the system includes computer-readable media having computer executable instructions and software is included in the ad insertion device - see column 6 lines 48-50 line 26-36; col. 15, lines 40-44).

8. Claims 12-14 and 16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Siler (US 20040133467 A1) in view of Rashkovskiy (US 6,912,504 B1) and further in view of Kanter (US 20020032608 A1).

Regarding claim 12, Siler discloses a method for displaying advertising in conjunction with a streaming video program comprising: presenting a streaming video program in a video presentation window (e.g., via media player window - 0027); receiving an ad event signal (trigger signal- see 0019, 0034); continuing presentation of the streaming video program

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(continuing playing the stream video program in window media player window - see 0027-0028); overlaying the streaming video program with an advertisement in response to the ad event signal (i.e., overlaying of advertisement in response to the trigger signal - see 0005, 0028, 0034); and continuing presentation of the streaming video program (continuing playing the stream video program in window media player window - see 0027-0028).

Siler does not teach checking the size of the video presentation window in response to the ad insert event signal and adjusting the video presentation window to a predetermined size if the video presentation window is of another size. However, Rashkovskiy teaches that advertisement is displayed in a reduced size in response to a control signal. This encompasses checking the size of other window since the window for presenting advertisement may be displayed in reduced size, e.g., picture-in-picture. See col. 3, lines 10-16. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Siler by checking the size of the video presentation window in response to the ad insert event signal and adjusting the video presentation window to a predetermined size if the video presentation window is of another size as taught by Rashkovskiy in order to increase effectiveness of presenting advertisement to viewer.

Both Siler and Rashkovskiy fail to teach disabling at least one previously-enabled size control function of the display window. However, Kanter discloses that user has no control over the ad window such as minimizing the ad. See 0017. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the combined system of Siler and Rashkovskiy by disabling at least one previously-enabled size control function, e.g., minimizing the display window, as disclosed in Kanter in order to allow advertiser to maximize the effectiveness of their ad campaigns.

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Regarding claim 13, Siler teaches that the trigger signal is embedded in the streaming video program (see 0019).

Regarding claim 14, Siler discloses that the trigger signal is generated by a software program operating at the receiver (see 0015, 0019, 0020).

Regarding claim 16, Siler teaches re-enabling said at least one control function of said video presentation window (for example, the user may close the media player window after the streaming video program is complete - see 0027).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NGOC K. VU whose telephone number is (571)272-7306. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John W. Miller can be reached on 571-272-7353. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/NGOC K. VU/  
Primary Examiner, Art Unit 2623